

REMARKS/ARGUMENTS

The Official Action rejects the claims under 35 U.S.C. § 101 as being directed to non-statutory subject matter. As explained below, the method of the claimed invention is directed to statutory subject matter and this rejection is therefore traversed. The Official Action also rejects Claims 1-4, 6 and 7 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,285,986 to Christopher C. Andrews, Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over the Andrews '986 patent in view of Official Notice and claims 8-13 under 35 U.S.C. § 103(a) as being unpatentable over the Andrews '986 patent in view of U.S. Patent No. 6,138,105 to Jay S. Walker, et al. As is also described below, independent Claim 1 has been amended to further highlight the patentable distinctions relative to the cited references, taken either individually or in combination. The Official Action also objects to the drawings and the specification for several informalities and replacement drawings of Figures 1 and 2 are submitted herewith and the specification has been amended so as to address each of the objections. Finally, the Official Action objected to Claim 5 for a typographical error and Claim 5 has now been amended to correct the typographical error and to overcome the objection to Claim 5. In view of the foregoing amendments and the following remarks, Applicants request reconsideration of the present application and allowance of the amended set of claims.

The Informalities in the Drawings and the Specification Have Been Addressed

The Official Action objected to Figure 1 for utilizing reference character "108" to refer to both a "catagory state" and a "provider". As reflected by the replacement drawing submitted for Figure 1, the provider that was previously designated as "108" has now been designated as "109". Similarly, page 8 of the specification has been amended to reference provider 109. As such the objection to the drawings is therefore overcome.

The Official Action also objected to the specification for several informalities involving reference characters. Relative to the inadvertent designation of the consumer as "202" in Figure 2, Figure 2 has now been amended as reflected by the replacement drawing submitted for Figure 2 to designate the consumer as "102". Further, page 12 of the specification has been amended to

correctly reference the package request processor as “206” and to insert a reference to step “304”. Moreover, page 13 of the specification has been amended to insert a reference to step “506”. As such, the objection to the specification has therefore been overcome.

The Claims are Statutory

Patentable subject matter is defined by 35 U.S.C. §101. “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.” The Federal Circuit has interpreted 35 U.S.C. §101 as requiring an invention to fall into one of the process, machine, manufacture or composition of matter categories. “The plain and unambiguous meaning of §101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35, i.e., those found in §§ 102, 103 and 112, ¶2.” *See State Street Bank & Trust Co. v. Signature Financial*, 149 F.3d 1368, 1372 (Fed. Cir. 1998).

Also in *State Street Bank*, the Federal Circuit described three categories of nonpatentable subject matter namely, laws of nature, natural phenomena, and abstract ideas. *See, id.* at 1373. With respect to abstract ideas, the Federal Circuit reaffirmed that mere mathematical algorithms devoid of some “useful, concrete and tangible result” are specifically not patentable. *See, id.* The Manual of Patent Examining Procedure (“MPEP”) reflects the Federal Circuit’s decision by stating that the “purpose of this requirement is to limit patent protection that have a level of ‘real world’ value, as opposed to nothing more than an idea or concept.” *See*, MPEP §2106 II. A. In addition, the MPEP proffers a stringent requirement for asserting a lack of utility under §101. “Office personnel have the burden to establish a *prima facie* case that the claimed invention as whole is **directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result**. Only when the claim is **devoid of any limitation to a practical application** in the technological arts should it be rejected under 35 U.S.C. 101,” (emphasis added). *See, id.*

As a basis for the rejection under 35 U.S.C. §101, it was alleged in the Official Action that the claims of the present application are directed to a process that does nothing more than manipulate an abstract idea and therefore are not patentable subject matter. “Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract. There is no practical application in the technological arts.” See Official Action, page 3, fifth paragraph.

Applicants respectfully disagree. Each of the pending claims of the present application describes a method producing a “useful, concrete and tangible result” as per the Federal Circuit’s interpretation of the requirements of 35 U.S.C. §101. For instance, independent Claim 1 recites a computer-implemented method for providing information on packages of interest. As a whole, Claim 1 recites a method that is useful for generating packages of items from a plurality of different providers to satisfy a request that has been received, such as from a potential customer, and for thereafter providing information regarding the package that has been generated.

As described by the specification, the method of Claim 1 has a very practical application in that providers are able to have their items packaged in manners that increase the likelihood that their items may be sold while at the same time permitting providers to discount their items without necessarily notifying the customer of the extent of the discount. The method of Claim 1 also serves a practical purpose for the customer in that the customer is capable of quickly identifying a package comprised of several items that matches their request, thereby reducing the time that the customer would otherwise expend to identify the items individually.

The method of Claim 1 also produces a concrete and tangible result by providing information regarding the package(s) that have been generated. Notably, the invention in contention in *State Street Bank* also involved the determination of numerical values that were, in effect, share prices. In holding that the claimed system at issue in *State Street Bank* was statutory subject matter, the Federal Circuit stated, “the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula or

calculation, because it produces 'a useful, concrete and tangible result' – a final share price momentarily fixed for recording and reporting purposes ... *State Street Bank*, 149 F.3d 1368, 1373. In the same manner that the determination of share prices was adjudged by the Federal Circuit to be a concrete, tangible and useful result, the information provided by the method of the claimed invention is a concrete, tangible and useful result and is evidence of the practical application of the claimed invention. In addition to Claim 1, the other claims that stand rejected under 35 U.S.C. § 101 depend from Claim 1 and therefore also recite a method of generating packages of items and thereafter providing information on the packages. Therefore, the rejection under §101 of all of the pending Claims 1-36 has been overcome.

Claims 1-13 are Patentably Distinct

As described above, the Official Action rejects Claims 1-13 in light of the Andrews '986 patent, taken either individually or in combination with Official Notice or with the Walker '105 patent. Amended independent Claim 1 sets forth a computer-implemented method for providing information on packages items. A recited, a request is received that identifies an interest in a set of items. Potential providers are identified that are capable of providing items that may satisfy the identified interests. As now amended, the potential providers are identified in response to receiving the request. Multiple items from a plurality of different providers selected from among the potential providers are then packaged to form a package of items. As now amended, the packaging of multiple items again occurs in response to receiving the request. Based upon the package of items, compensation that would be owed to at least one selling agent is determined. Finally, information reflecting the package of items is provided in response to the request.

The Andrews '986 patent describes a method and apparatus for bundling various products and services for one or more vendors into a bundle that is sold as a unit. As described, one or more vendors post information about their products and services. Bundle vendors then generate bundles of the products and services posted by the various vendors. Vendors may then view the various bundles and select and purchase one or more bundles. When a bundle is purchased by a member, the products or services within the bundle are shipped to the member either as a unit or separately from the participant vendor.

The Walker '105 patent describes the packaging of a group of products for sale at a single price. In assembling the packages, the system and method assemble products into packages in accordance with a package assembly rules table. In this regard, The system and method generate packages that include a number of different product families that have been defined by the package assembly rules table as being complimentary. Among other parameters, the sales performance of the products may be considered, at least in terms of setting the price of the resulting package and thereafter in terms of maintaining the viability of the package. As such, if the sales performance data for the products included in the package fails to meet predefined limits, the package may be rendered invalid and the method and system may reconstitute other packages.

As now recited by amended independent Claim 1, the package of items is generated in response to receiving a request that identifies an interest in a set of items. Thus, after receiving the request, potential providers of items that may satisfy the identified interests are identified and multiple items from a plurality of different providers are packaged into a package of items. Thus, the method of independent Claim 1 generates the packages in response to a request, such as from a potential purchaser. In marked contrast, both the Andrews '986 patent and the Walker '105 patent generate the various packages in advance of any requests from a potential purchaser or otherwise. As such, a potential purchaser of the systems described by the Andrews '986 patent and the Walker '105 patent essentially chooses amongst existing packages, as opposed to having a package newly created for them in response to their request, as recited by amended independent Claim 1. By constructing the package in response to the request from the potential purchaser, the method of the claimed invention offers several advantages relative to the prepackaging techniques described by the Andrews '986 patent and the Walker '105 patent. In this regard, a method of the claimed invention may be capable of generating packages that more precisely match the parameters defined by the request submitted by a potential purchaser. In addition, by generating the packages in response to a request, such as a request submitted by a potential purchaser, the packages may be generated based upon more current data relating to the inventory of the various potential providers and the availability of the requested items such that

the items included within the package that is generated have a greater chance of being available if the customer chooses to purchase the package.

As noted above, independent Claim 1 has also been amended to recite that compensation to at least one selling agent is determined based upon the package of items. By determining the compensation that would be owed to at least one selling agent following the packaging of the items, the determination can take into account any arrangements, contracts or the like between the various providers of the items included within the package and the selling agent(s), as well as the overall pricing of the package. Accordingly, the selling agent will have an accurate view of the compensation to which the selling agent would be entitled if the perspective customer purchases the package. Neither of the recited references, taken either individually or in combination, teaches or suggests the determination of any type of compensation to a selling agent as now recited by amended independent Claim 1.

Applicants note that the Official Action has taken Official Notice with respect to the steps set forth by dependent Claim 5 that one or more selling agents and notified potential providers are compensated based on a commission structure, a net structure or a combination of a commission structure and a net structure. Initially, it is noted that the recitation of dependent Claim 5 differs from the additional step now set forth by independent Claim 1 in that amended independent Claim 1 now recites that the compensation due to at least one selling agent is determined based upon the package of items. Thus, the determination of the compensation of at least one selling agent is determined following the packaging of multiple items and is based upon the package of items, as now recited by independent Claim 1. While the compensation of a selling agent or a potential provider based on some type of commission structure may be well known, Applicants submit that it is not well known to determine the compensation due to at least one selling agent based upon a package of items that has been generated in response to a request, such as from a potential purchaser, as now recited by amended independent Claim 1. If the Examiner continues to contend that amended independent Claim 1 is not patentable, Applicants respectfully request documentary proof, as permitted by MPEP § 2144.03, of the determination of compensation to at least one selling agent based upon the package of items as recited by amended independent Claim 1.

For each of the reasons described above, amended independent Claim 1 is not taught or suggested by the cited references. Since dependent Claims 2-13 include each of the recitations of amended independent Claim 1, dependent Claims 2-12 are also not taught or suggested by the cited references, taken either individually or in combination, for at least the same reasons as described above in conjunction with amended independent Claim 1. Thus, the rejections of Claims 1-13 under 35 U.S.C. §§ 102(e) and 103(a) are therefore overcome.

New Claims 14-18

New independent Claim 14 and new dependant Claims 15-18 are also submitted herewith to recite a system for providing information on packages of items in a manner comparable to the method set forth by independent Claim 1 and described above. In this regard, the system of independent Claim 14 includes a package request processor for receiving a request identifying an interest in a set of items and an item/provider database, responsive to queries from the package request processor in response to the request, for identifying potential providers capable of providing items that satisfy the identified interest. The package request processor packages multiple items from a plurality of different providers identified by the item/provider database into a package of items. The system of new independent Claim 14 also includes a compensation processor for receiving the package of items generated by the package request processor and for determining compensation for at least one selling agent based on the package of items. The compensation processor also provides information regarding the package of items, such as to a potential customer.

For the reasons described in conjunction with amended independent Claim 1, Applicants respectfully submit that new independent Claim 14 is also patentably distinct from the cited references, taken either individually or in combination. Furthermore, new dependent Claims 15-18 include additional recitations that further patentably distinguish the system of the claimed invention from the cited references. In this regard, dependent Claim 15 recites that the compensation processor notifies at least one selling agent of the compensation that has been determined based upon the package of items without similarly notifying a potential customer. Claim 16 recites that the compensation processor also determines the compensation for at least

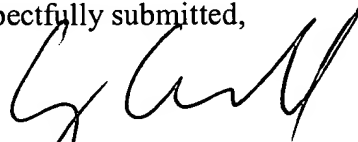
one provider. Furthermore, Claim 17 recites that the package request processor generates the package of items based at least partially upon agreements with potential providers. Since new Claims 14-18 are not taught or suggested by the cited references, taken either individually or in combination, Applicants respectfully request allowance of these newly submitted claims.

CONCLUSION

In light of the amended drawings and specification, the amended and newly added claims and the remarks submitted above, Applicants submit that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

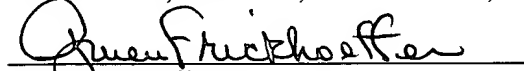


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